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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,052	12/26/2001	Timo Vataja	460-010812-US(PAR	6806
2512	7590	03/22/2006	EXAMINER	
PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			KAROVALIA, SAMIR	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/033,052

Applicant(s)

VATAJA, TIMO

Examiner

Samir S. Karovalia

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2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This office action is in response to applicant's request for continued examination filed on 12/12/2005. Claims 1-3 and 5-24 are currently pending in the application.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 5-9, 11-18 and 20-24 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,754,484 B1 to Hiltunen et al. (hereinafter, "Hiltunen") of record.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

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In regard to claim 1, Hiltunen discloses a method for transmitting location-based message within a communication system, the method comprises at least the following steps:

a positioning step for determining the position of the sender's wireless communication device [see col. 1, lines 48-61],

a range definition step for defining the message transmission range based on the current position of the sender's wireless communication device (see col. 1, lines 48-61, range definition being the operating area of the beacon),

a validity period definition (i.e., time limitation parameter) step for defining a validity period for the message (see col. 2, lines 5-11),

a step of sending the message from the wireless communication device of the sender to the communication system (see abstract, col. 1, line 62 – col. 2, line 4, where a message is transferred from a sender to a recipient directly or through the communication system),

a detection step for detecting whether the recipient of the message is located within the message transmission range (see FIG. 3, step 3.8, where the presence of a recipient's device is detected), and

a presentation step, wherein via the communication system, the message is presented in the wireless communication device of the recipient, in case said recipient of the message is located

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within the message transmission range (see col. 7, lines 21-26, where a message is transmitted to devices that are within the operation range of the beacon).

In regard to claim 16, claim 16 does not substantially differ from claim 1 in that it recites a system comprising the means to carryout the method of claim 1. Therefore, see the claim 1 rejection for details.

In regard to claim 22, claim 22 does not substantially differ from claim 1 in that it recites a message service center comprising the means to carryout the method of claim 1. Therefore, see the claim 1 rejection for details.

In regard to claim 23, claim 23 does not substantially differ from claim 1 in that it recites a wireless communication device comprising the means to carryout the method of claim 1. Therefore, see the claim 1 rejection for details. Also, see col. 1, line 48 – col. 2, line 26.

In regard to claim 24, claim 24 does not substantially differ from claim 1 in that it recites a wireless communication device comprising the means to carryout the method of claim 1, with the exception of the limitation “storage means for storing message” (see FIG. 3, step 3.3 and col. 6, lines 6-28). Therefore, see the claim 1 rejection for details.

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In regard to claim 2, see col. 5, lines 12-28, where a selected group is intended to receive the message.

In regard to claim 3, see col. 7, lines 21-26, where a message is transmitted to devices (i.e., anyone) that are within the operation range of the beacon.

In regard to claim 5, see col. 3, lines 21-39, where the network (i.e. communication system) between the devices is responsible for storing and routing messages.

In regard to claim 6, see abstract, col. 1, line 62 – col. 2, line 4 and col. 7, lines 42-64, where a message is transferred from a sender to a recipient directly or through the communication system. Furthermore, it is apparent that during direct transfer from the sender to a recipient the message is transferred to the recipient where it is stored for viewing.

In regard to claim 7 and 18, see col. 1, lines 12-20 and col. 4, line 45, where Hiltunen disclose the use of a GSM network which inherently comprises a base station (BS) in order arrange communication between wireless communication device. Furthermore, the beacon transmitter (BT) reads on a BS.

In regard to claims 8 and 9, Hiltunen discloses the transfer of the message through the use of plurality of beacons (e.g., Home Location Register (HLR) and Visiting Location Registers (VLRs)). The HLR would in this case be the area, which the wireless communication device of the sender communicates within and the VLRs would be the area where a sender's communication device can receive the transmitting message.

In regard to claims 11, 12, 20 and 21, Hiltunen discloses the use of short-range wireless communication network (i.e. Bluetooth), which directly or indirectly connects wireless devices for location-based messaging, thus forming a wireless local area network. For further details, see the claim 1 rejection for details.

In regard to claim 13, range of the beacon is a geographical area which would be the message transmission range. See, the claim 1 rejection for further details.

In regard to claim 14 and 15, Hiltunen discloses use of GSM network (see col. 1, lines 12-20 and col. 4, line 45), wherein the presence of a mobile station (MS) is determined through pilot signal transmitted in intervals and when a MS enters a new operating area it registers itself [i.e., sets up communication between the MS and the base station (i.e., communication device)].

In regard to claim 17, see the claim 1 rejection for details.

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1, 10, 16, 19 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,119,014 to Alperovich et al. (hereinafter, "Alperovich") in view of U.S. Patent No. 5,946,630 to Willars et al. (hereinafter, "Willars"), of record.

In regard to claim 1, Alperovich discloses a method for transmitting location-based message within a communication system, the method comprises at least the following steps:

a positioning step for determining the position of the sender's wireless communication device [see abstract, col. 2, line 28 – col.



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3, line 11, where the origination of the SMS at the serving MSC/VLR is the position of the sender],

a range definition step for defining the message transmission range based on the current position of the sender's wireless communication device (see abstract, where the sender specifies that a message is to be delivered only when a subscriber is in a certain area),

a step of sending the message from the wireless communication device of the sender to the communication system (see abstract, FIG. 3, and col. 4, lines 29-31, an SMS message is forwarded from a subscriber to the a recipient MS),

a detection step for detecting whether the recipient of the message is located within the message transmission range (see col. 5, lines 50-58, where the system periodically checks to see if the recipient MS is within the location area specified by the sender), and

a presentation step, wherein via the communication system, the message is presented in the wireless communication device of the recipient, in case said recipient of the message is located within the message transmission range (see col. 5, lines 50-58, where once the recipient MS is in the location specified by the sender, the SMS is forwarded to the recipient for viewing/presenting).

Although, Alperovich discloses the limitations stated above and also provides a method for a sender to specify the time of delivery (see col. 4, lines 52-65), he fails to

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expressly disclose a validity period definition step for defining a validity period for the message,

However, Willars teaches a method where a sender of an SMS message specifies a validity period after which the destination SMS-C discards the SMS message (col. 4, lines 45-54).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the teaching of Alperovich and provide a validity period definition step for a sender to specify a validity period for a SMS message intended for a recipient MS so that if the SMS was not forwarded to a recipient within a specified time the SMS system can discard the message. The motivation to modify the teaching of Alperovich would have been to conserve memory space for newer messages.

In regard to claim 16, claim 16 does not substantially differ from claim 1 in that it recites a system comprising the means to carryout the method of claim 1. Therefore, see the claim 1 rejection for details.

In regard to claim 22, claim 22 does not substantially differ from claim 1 in that it recites a message service center comprising the means to carryout the method of claim 1. Therefore, see the claim 1 rejection for details.

In regard to claim 23, claim 23 does not substantially differ from claim 1 in that it recites a wireless communication device comprising the means to carryout the method of claim 1. Therefore, see the claim 1 rejection for details.

In regard to claim 24, claim 24 does not substantially differ from claim 1 in that it recites a wireless communication device comprising the means to carryout the method of claim 1, with the exception of the limitation "storage means for storing message" (see abstract, where a sender specifies a delivery time for the message, thus the system inherently stores the message for delivery at the specified time). Therefore, see the claim 1 rejection for details.

In regard to claims 10 and 19, see Alperovich, see col. 5, lines 27-34, where the location area is a latitude and longitude coordinates (i.e., Global Positioning Satellite points) or a specific geographical reference points.

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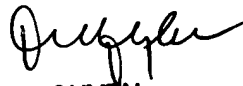
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samir S. Karovalia whose telephone number is (571)272-8133. The examiner can normally be reached on Monday-Friday, 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on (571)272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**DUC NGUYEN**  
**PRIMARY EXAMINER**